

Remarks

Claim 1 is pending in the application and is amended to correct a typographical error. Claims 2-4 are added to the application. Claim 1 stands rejected under 35 U.S.C. 101 for lacking a statutory basis.

Rejections under 35 U.S.C. §101

The Examiner deems Claim 1 to be non-statutory, because the claim is not limited to the technological arts. The Examiner states that all recited steps could be performed manually by a human and, therefore, Applicant's invention fails to "promote the progress of science and the useful arts." Accordingly, the Examiner concludes that the Applicant's claim does not meet the technological arts requirement of 35 U.S.C. 101.

Applicant respectfully disagrees with the Examiner's conclusion. Applicant submits that Claim 1 is a process for scoring a competition to determine a winning team – a useful, concrete, and tangible result -- while encouraging each team to engage in good sportsmanship.¹ This result is a useful application of the algorithm and, thus, the claim is directed to a statutory subject matter as similarly held by the U.S. Court of Appeals for the Federal Circuit in *AT&T Corp. v. Excel Communications Inc.*, 172 F.3d 1352, 1355 (Fed. Cir. 1999).

The Examiner, in her rejection, is requiring Applicant's claim to meet a different standard under 35 U.S.C. § 101. Using *Ex Parte Bowman* as the basis for this rejection, the Examiner asserts that a claim that recites an algorithm is directed to statutory subject matter ONLY if the claim recites one or more "physical aspects" that are within the technological arts regardless of whether the algorithm generates a useful, concrete, or tangible result. This new *Bowman* standard requires that the claim meet two criteria: 1) be in the technological arts AND 2) generate a useful, concrete, and tangible result. This test is different from the well-known test articulated by the U.S. Court of Appeals for the Federal Circuit (in *AT&T*) that requires a claim to be EITHER: 1) be in the technological arts OR 2) generate a useful, concrete, and tangible result.

In *AT&T*, the U.S. Court of Appeals for the Federal Circuit held that the method claim – a method in which inter-exchange calls initiated by each subscriber are routed over the facilities of a particular one of a plurality of inter-exchange carriers associated with that subscriber “comfortable falls with the scope of § 101.” *Id.* at 1359. According to the U.S. Court of Appeals for the Federal Circuit, because the “claimed process employs subscribers’ and call recipients’ PIC [indicators] as data, applies Boolean algebra to those data to determine the value of the PIC indicator, and applies the value through switching and recording mechanisms, it creates a signal useful for billing purposes.” *Id.* at 1359. The Court held that the claim at issue was directed to statutory subject matter because “the claimed process applies Boolean principle to a useful, concrete, tangible result without pre-empting other uses of the mathematical principle.” *Id.* Accordingly, the “useful, concrete, tangible result” of the claimed process was the claimed PIC indicator, which represents “information about the call recipients’ PIC, a useful, non-abstract result that facilitates differential billing of long-distance calls made by an IXC’s subscriber.” *Id.*

Similarly, the process of scoring a competition to determine a winning team produces a useful, concrete, tangible result. The scores of the first and second teams are data analogous to the subscribers’ and call recipients’ PIC data of the above case. Comparing and computing the data produces a result such as a winning team that fosters competition. Stated differently, because the winning team gets the losing team’s score (times two), it is in the winning team’s self-interest to win, but to ensure that the losing team performs as well as possible without exceeding the winning team’s score. This underlying incentive -- not to beat the losing team by as wide a margin as possible, but to ensure that all teams perform with graceful professionalism – fosters good competition between the teams. Comparing and computing the data to select a winner, while nevertheless encouraging graceful professionalism, is directed to statutory subject matter.

¹ The process is an algorithm. The U.S. Court of Appeals for the Federal Circuit has stated that “any step-by-step process, be it electric, chemical, or mechanical is an ‘algorithm’ in the broadest sense of the word. *AT&T Corp. v. Excel Communications Inc.*, 172 F.3d 1352, 1355 (Fed. Cir. 1999).

Conclusion

In sum, Applicant's claim generates a result that is a useful application of the method. This result in and of itself deems the claim to be of statutory subject matter under 35 U.S.C. § 101.

Applicant respectfully requests reconsideration of the claim and withdrawal of the rejection under 35 U.S.C. § 101.

The Examiner is requested to telephone the undersigned if any matters remain outstanding so that they may be resolved expeditiously.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Maureen K. Toohey', with a stylized flourish at the end.

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